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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,783

Applicant(s)

LEDERMAN, LAWRENCE

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-115 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 and 24-115 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 18-22 and 24-115 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to applicant's communications filed on December 1, 2003. Amendments to specification and claims 1, 18-22 and addition of new claims 23-115 have been entered. Claims 1-115 are currently pending. Claims 1-115 are subject to restriction as discussed below. The Examiner acknowledges applicant's provisional election, without traverse, of claims 1-17 and 23. Claims 18-22 and 24-115 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 1-17 and 23 have been examined. Applicant's arguments with regard to rejection of claims 1-17 and 20-22 made under 35 U.S.C. § 112, first paragraph in the last office action (Paper No. 3) are persuasive and hence these rejections are withdrawn by the Examiner. The restriction/election, objection to specification, rejections and response to arguments are stated below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17 and 23, drawn to a method for managing concentration of debt, the method comprising: determining a debt concentration threshold; and associating a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 37.

II. Claims 18 and 42-53, drawn to a method for managing concentration of debt, the method comprising: determining a debt concentration threshold; associating a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; issuing the debt instrument with associated condition; monitoring concentration of debt instruments by entities; and changing at least one parameter of the debt instrument; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

III. Claims 19 and 54-65, drawn to a method for managing concentration of debt, the method comprising: issuing a debt instrument; determining a debt concentration threshold; associating a condition with the debt instrument after issue of the debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; monitoring concentration of debt instruments by entities; and changing at least one parameter of the debt instrument; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

IV. Claims 20 and 66-82, drawn to a computer executable software code transmitted as an information signal, the code for managing concentration of debt, the code comprising: code to determine a debt concentration thresholds; code to associate a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition

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available when an entity holds more debt instruments than the debt concentration threshold; and code to provide one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

V. Claims 21 and 83-99, drawn to a computer readable medium having computer executable software code stored thereon, the code for managing concentration of debt, the code comprising: code to determine a debt concentration threshold; code to associate a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and code to provide one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

VI. Claims 22 and 100-115, drawn to a programmed computer for managing concentration of debt, comprising: a memory having at least one region for storing computer executable software code; and a processor for executing the program code stored in memory, wherein the program code comprises: code to determine a debt concentration threshold; code to associate a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and code to provide one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

VII. Claims 24-41, drawn to a programmed computer for managing concentration of debt, comprising: a memory having at least one region for storing computer executable software code; and a processor for executing the program code stored in memory, wherein the program code comprises: code to determine a debt concentration threshold; code to associate a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and code to provide one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, classified in class 705, subclass 35.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I is related to a for managing concentration of debt, the method including associating a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, whereas invention II is related to a method for managing concentration of debt, the method including issuing the debt instrument with associated condition; monitoring concentration of debt instruments by entities; and changing at least one parameter of the debt instrument; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt

instrument. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Inventions I and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I is related to a for managing concentration of debt, the method including associating a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, whereas invention III is related to a method for managing concentration of debt, the method including issuing a debt instrument; determining a debt concentration threshold; associating a condition with the debt instrument after issue of the debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; monitoring concentration of debt instruments by entities; and changing at least one parameter of the debt instrument; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Inventions I and IV are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I is related to a for managing concentration of debt, the method including associating a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument, whereas invention IV is related to a computer executable software code transmitted as an information signal, the code for managing concentration of debt, the code comprising: code to determine a debt concentration thresholds; code to associate a condition with a debt instrument, the condition changing at least one parameter of the debt instrument, the condition available when an entity holds more debt instruments than the debt concentration threshold; and code to provide one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group IV, restriction for examination purposes as indicated is proper even though they are classified in the same class and sub class.

Similarly other pairing of inventions stated above are related as sub combinations disclosed as usable together in a single combination. These inventions are distinct from each other as can be evident from the definition of the groups described above. Also they require separate searches and hence restriction of these inventions for examination purposes as indicated

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is proper.

4. During a telephone conversation with Mr. Chris Holm on February 10, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17 and 23. Applicant in replying to this Office action must make affirmation of this election. Claims 18-22 and 24-115 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification as originally filed, and the current amendments to the specification do not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1-17 and 23 include the limitation "providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument". However, the specification does not provide an enabling disclosure to support the claimed step of "providing one or more company representatives

with unilateral authority to implement the condition and change a parameter of the debt instrument”.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-17 and 23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1-17 and 23 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (US Patent 6,148,293) as discussed in paragraph 5 of the last office action (Paper No. 3). The added limitation “providing one or more company representatives with unilateral authority to implement the condition and change a parameter of the debt instrument” has not been

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considered in making the rejection in view of the objections to the specification and rejection under 35 U.S.C. 112, first paragraph discussed above.

Response to Arguments

11. Applicant's arguments with respect to rejection of claims 1-22 under 35 U.S.C. 103(a) have been considered but are not persuasive.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or

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Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
February 12, 2004

~~Richard Weisberger~~
~~Primary Examiner~~